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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,766	11/23/2001	Sho Kuwamoto	1281	5315

30748 7590 11/02/2005

INNOVATION PARTNERS
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EXAMINER

RIES, LAURIE ANNE

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/991,766	Applicant(s) KUWAMOTO ET AL.	
	Examiner Laurie Ries	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-14, 16-24 and 26-30 is/are rejected.
- 7) ☒ Claim(s) 5, 15 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment, filed 17 August 2005, to the original application filed 23 November 2001.
2. Claims 1-4, 8, 11-14, 18, 21-24, and 28 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey (U.S. Publication 2002/0059278 A1, claiming priority of U.S. Provisional Application Number 60/201234) and Chiang (U.S. Publication 2001/0037490 A1, claiming priority of U.S. Provisional Application Number 60/190364).
3. Claims 6-7, 16-17, and 26-27 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey (U.S. Publication 2002/0059278 A1, claiming priority of U.S. Provisional Application Number 60/201234), Chiang (U.S. Publication 2001/0037490 A1, claiming priority of U.S. Provisional Application Number 60/190364) and Guck (U.S. Patent 5,911,776).
4. Claims 9-10, 19-20, and 29-30 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Guck (U.S. Patent 5,911,776) and Bailey (U.S. Publication 2002/0059278 A1, claiming priority of U.S. Provisional Application Number 60/201234).

5. Claims 1-30 are pending. Claims 1, 9, 11, 19, 21, and 29 are independent claims.

Response to Arguments

6. Applicant's arguments filed 17 August 2005 have been fully considered but they are not persuasive.

Regarding Applicant's argument on Page 11 of the Instant Amendment that the motivation to combine Bailey and Chiang is improper due to the use of an HTML editor that is not capable of being run on a server computer. The Office respectfully disagrees. A server computer is merely a computer with additional administrative software loaded that enables said computer to control access to the network and network resources (See Microsoft Computer Dictionary, Third Edition, Page 430, definition of "server"). Therefore, any software that may be run on a client computer, such as a basic HTML editor, may also be run on a server computer.

Regarding Applicant's argument on Page 11-12 of the Instant Amendment that the Office presents Bailey, Figure 2, Element 218, as disclosing the limitation of storing a file responsive to the information to be contained in the file. The Office agrees that this element is not contained in Figure 2 of the Bailey provisional application as

asserted by Applicant, however, disclosure of the limitation is provided in the Bailey provisional application, Page 9, lines 9-14.

Regarding Applicant's argument on Page 13 of the Instant Amendment that Guck fails to disclose retrieving two files, the Office respectfully disagrees. Guck discloses that Figure 2A displays files that can be utilized through the server in multiple numbers of other formats. Guck also discloses that these files are stored in the database of Figure 1, reflecting the various files shown in Figure 2A, which include files in multiple formats that might used or retrieved (See Guck, Column 7, lines 47-59).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 8, 11-14, 18, 21-24, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey (U.S. Publication 2002/0059278 A1, claiming priority of U.S. Provisional Application Number 60/201234) and Chiang (U.S. Publication 2001/0037490 A1, claiming priority of U.S. Provisional Application Number 60/190364).

As per claims 1, 11, and 21, Bailey discloses a system, computer program product, and method of storing a file and information related to the file and not contained in the file, including receiving information to be contained in the file (See

Bailey Provisional Application, Page 6, lines 5-7), receiving information related to the file and not contained in the file (See Bailey Provisional Application, page 6, lines 7-9), storing the file responsive to the information to be contained in the file received (See Bailey, Figure 2, element 218), and storing in a shadow file different from the file, the information related to the file and not contained in the file (See Bailey Provisional Application, Page 9, lines 9-14). Bailey does not disclose expressly using a web authoring tool to receive the information. Chiang discloses the use of an HTML editor, which is a web authoring tool. (See Chiang Provisional Application, Figure 1, and Page 2, lines 4-5). Bailey and Chiang are analogous art because they are from the same field of endeavor of generating electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the web authoring tool of Chiang with the information files of Bailey. The motivation for doing so would have been to allow the developer ease of graphical design and high performance. (See Chiang Provisional Application, Page 1, line 20). Therefore, it would have been obvious to combine Chiang with Bailey for the benefit of allowing the developer ease of graphical design and high performance to obtain the invention as specified in claims 1, 11, and 21.

As per claims 2, 12, and 22, Bailey and Chiang disclose the limitations of claims 1, 11, and 21 as described above. Bailey also discloses that the shadow file containing information related to the file is an XML file, which, by definition, contains XML tags. (See Bailey Provisional Application, Page 3, line 21, and Page 4, line 1).

As per claims 3, 13, and 23, Bailey and Chiang disclose the limitations of claims 1, 11, and 21 as described above. Bailey also discloses that the file is an HTML file, which, by definition, contains HTML code. (See Bailey Provisional Application, Page 4, lines 2-3).

As per claims 4, 14, and 24, Bailey and Chiang disclose the limitations of claims 1, 11, and 21 as described above. Bailey also discloses receiving a request to open the file and automatically displaying at least a portion of the information related to the file in the shadow file responsive to the request (See Bailey Provisional Application, Page 3, lines 18-19).

As per claims 8, 18, and 28, Bailey and Chiang disclose the limitations of claims 1, 11, and 21 as described above. Chiang also discloses that the web authoring tool, or HTML editor, includes at least a portion of Adobe GoLive (See Chiang Provisional Application, Figure 1, and Page 2, lines 4-5). Bailey and Chiang are analogous art because they are from the same field of endeavor of generating electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include Adobe GoLive as the web authoring tool or HTML editor disclosed by Chiang and Bailey. The motivation for doing so would have been to allow the developer ease of graphical design and high performance. (See Chiang Provisional Application, Page 1, line 20). Therefore, it would have been obvious to combine Chiang with Bailey for the benefit of allowing the developer ease of graphical design and high performance to obtain the invention as specified in claims 8, 18, and 28.

8. Claims 6-7, 16-17, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey (U.S. Publication 2002/0059278 A1) and Chiang (U.S. Publication 2001/0037490 A1) as applied to claims 1, 11, and 21 above, and further in view of Guck (U.S. Patent 5,911,776).

As per claims 6-7, 16-17, and 26-27, Bailey and Chiang disclose the limitations of claims 1, 11, and 21 as described above. Bailey and Chiang do not disclose expressly that the shadow file includes a name corresponding to a name of the file, or that the shadow file includes the file name. Guck discloses that a shadow file name can correspond to the name of a source file and can contain the name of the source file. (See Guck, Figure 2A). Bailey, Chiang and Guck are analogous art because they are from the same field of endeavor of generating electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the shadow file names of Guck with the shadow file of Bailey and Chiang. The motivation for doing so would have been to allow a user to only refer to a file by name rather than remembering the file extension. (See Guck, Column 8, lines 50-51). Therefore, it would be obvious to combine Guck with Bailey and Chiang for the benefit of allowing the user to disregard the file extension when referring to the file to obtain the invention as specified in claims 6-7, 16-17, and 26-27.

9. Claims 9-10, 19-20, and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guck (U.S. Patent 5,911,776) and Bailey (U.S. Publication 2002/0059278 A1).

As per claims 9, 19, and 29, Guck discloses a system, computer program product, and method of retrieving a file including HTML and having a filename, which includes retrieving the file (See Guck Column 12, lines 21-24) and retrieving a shadow file having a filename including the filename of the file. (See Guck, Figure 2A). Guck does not disclose expressly that the shadow file contains information about the file. Bailey discloses a document template that defines default attributes of a document, document customization information and document personalization information. (See Bailey Provisional Application, Page 6, lines 7-11). Guck and Bailey are analogous art because they are from the same field of endeavor of generating electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the information content in the shadow file of Bailey with the shadow file of Guck. The motivation for doing so would have been to define the manner in which the page is to be constructed. (See Bailey, Page 6, lines 9-11). Therefore, it would have been obvious to combine Bailey with Guck for the benefit of providing information to define the page layout to obtain the invention as specified in claims 9, 19, and 29.

As per claims 10, 20 and 30, Guck and Bailey disclose the limitations of claims 9, 19 and 29 as described above. Guck also discloses that the filename of the shadow file can include multiple numbers of other formats (See Guck, Column 7, lines 37-53), including MPEG files which, as is known in the art, have an extension beginning with "m". (See Guck, Figure 8).

Allowable Subject Matter

10. **Claims 5, 15, and 25** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
10/30/2005